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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,129	11/07/2000	David N. Spiegel	END920000101US1	1094
7590	05/05/2004		EXAMINER	
ROANALD A. D'A;ESSANDRO HOFFMAN, WARNICK & D'ALESSANDRO THREE E-COMM SQUARE ALBANY, NY 12207			RUTTEN, JAMES D	
			ART UNIT	PAPER NUMBER
			2122	10
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/708,129	SPIEGEL, DAVID N.	
	Examiner J. Derek Ruttan	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 March 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-18 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 07 November 2000 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. Applicants' amendment dated March 15, 2004, responding to the January 13, 2004 Office Action provided in the rejection of claims 1-18, wherein claims 6, 9, and 14 have been amended. Claims 1-18 remain pending in the application and have been fully considered by the examiner.

Applicant has primarily argued that the claims are not anticipated by Stupek because it does not disclose each and every feature of the claims. This argument is not persuasive, as will be addressed under the *Prior Art's Arguments – Rejections* section below.

Prior Art's Arguments – Rejections

2. Applicant's arguments filed on March 15, 2004, in particular on pages 8 and 9, have been fully considered but they are not persuasive.

On page 8, last paragraph, Applicant contends that Stupek fails to disclose “*Searching said database for said prerequisite items and corequisite items corresponding to each of said third maintenance items on said first list, and adding said corresponding prerequisite items and corequisite items to said first list*”, and particularly that there is no mention of “*searching...for said prerequisite items and corequisite items*”. While the examiner pointed to column 4 lines 35-44 of Stupek in the previous Office action dated January 13, 2004, further examination is made in the rejection below to show that Stupek retrieves information from the database, and examines dependency information that describes prerequisites and corequisites included for each entry. The dependency information is an inherent part of a database entry and conforms to a predefined format and structure (See FIG. 5A elements 25h-25j). This predefined structure is established

for the purpose of efficient searching. Thus, such an examination of database information requires searching for particular elements, including the dependency information.

On page 9, first paragraph, Applicant contends that Stupek fails to disclose adding “*said corresponding prerequisite items and corequisite items to said first list.*” Further interpretation is made from column 4 lines 6-9, which discloses presenting a list of upgrades to a user. Stupek takes an original list of available upgrades and analyses it to determine the set of necessary upgrades. In other words, the first list is edited to include only those items that are not already present, and those items that are included in the above mentioned dependency field of the database entry. Thus, the corresponding prerequisite items and corequisite items are added to the first list.

On page 9 second paragraph, Applicant contends that Stupek fails to disclose “*Thereafter determining from said software recording application which items on said first list have already been received, and adding those items not received to an order list*”. Particularly, Applicant points to page 9 lines 17-18 of the specification to provide a definition of “received”. However, further review of this paragraph extends the definition to not only include “stored in a file on the computer system,” but further: “The item may have been stored in a file when the computer system was originally provided by the computer manufacturer. It may have been stored as a result of an earlier use of the present method, or as a result of some other maintenance procedure, or a file may have been provided in any other way known in the art for providing a file” (emphasis added). Such a definition is not restrictive, and the description by Stupek of available resources in column 3 lines 25-29, is indicative of an item that must have been received in some way known in the art. If it were never received, it could not have been installed.

On page 9 last paragraph, in regards to the amended claim 9, Applicant contends that Stupek fails to disclose that “the first list comprises a list of maintenance items needed to be applied to said computer system.” The examiner disagrees. Applicant further points out that Stupek’s resource upgrades “comprise a general list of all available upgrades,” but quotes Stupek from column 4 lines 3-5: “analyze each network resource 3 currently on the server 1 to determine the availability and necessity [or need] of the corresponding upgrade 7.” Further inspection of Stupek’s disclosure in column 4 lines 6-8 reveals: “When the analysis is complete, the upgrade advisor 11 presents a report and/or graphical display to the user. This output is in the form of upgrade recommendations...” Thus, Stupek analyses the system to deliver a list comprising a list of maintenance items needed to be applied. Further, regarding Stupek’s “general list” referred to by the Applicant, although it indeed consists of a list of all available upgrades as pointed out by the Applicant, this list is the basis for Stupek’s report, and thus must also *comprise* a list of maintenance items needed.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following items must be shown or the feature(s) canceled from the claim(s).

- Mainframe (claims 2 and 10)
- Network software (claims 4 and 12)
- Application tracking (claims 5 and 13)
- Service Link database application (claims 6 and 14)

- Storing items on order list in a file (claims 7 and 15)

No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by prior art of record U.S. Patent No. 5,960,189 to Stupek et al.

As per claim 1, Stupek discloses:

A method of maintaining software on a computer system (See Abstract)

comprising the steps of:

Bringing up first and second host sessions on a computer system (FIG. 1 elements 1 and 2);

Starting in said first host session, a software recording application having data on first maintenance items applied to said computer system (figure 1 reference 5

“Management Information Base”, column 3 lines 22-30, “A management information base (MIB) within the server **maintains basic descriptive information** about each of the resources available on the server.”);

Starting in said second host session, a database application having a database of second maintenance items including prerequisite items and corequisite items corresponding to each of said second maintenance items (figure 1 reference 9 “Upgrade Database”, column 3 lines 44-column 7 lines 8-10, “The database also contains information regarding the dependencies between the package and other upgrade objects or packages...”);

Activating a maintenance application on said computer system (figure 1 reference 11 “Upgrade Advisor”);

Entering a first list of third maintenance items in said maintenance application (figure 1 reference 7 “Resource Upgrades”, column 3 lines 31-43, “Upgrades to the network resources are provided to a server manager by a distribution medium...”);

Searching said database for said prerequisite items and corequisite items corresponding to each of said third maintenance items on said first list, and adding said corresponding prerequisite items and corequisite items to said first list (column 4 lines 20-27: “The upgrade advisor then **retrieves upgrade information from the upgrade database** and performs two types of comparisons: a) whether or not a particular upgrade package

corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource (i.e., whether or not the upgrade package represents a true upgrade for the existing network resource)."; also column 7 lines 29-33: "Therefore, the dependency information in the Package **database 25 describes not only the dependencies between packages on the CD, but also all dependencies** between an upgrade package and any upgrade not available on the CD.;" also column 4 lines 6-9: "When the analysis is complete, the **upgrade advisor 11 presents a report** and/or graphical display to the user. This output is in the form of **upgrade recommendations**, each supported by an explanation of the reasons for upgrade." Comment: The first list is analyzed by the upgrade advisor and modified according to the current maintenance needs, including a report, or list, of prerequisites and corequisites.);

Thereafter determining from said software recording application which items on said first list have already been received, and adding those items not received to an order list (column 4 lines 20-27 as cited above describes the determination of items that have already been received; also column 4 lines 45-48: "When the upgrade advisor 11 and/or the user have **selected 100 the network resources 3 that need to be upgraded**, an upgrade installer 17

oversees the automatic installation of the packages to the server." Comment: A determination of which items have already been received is inherent in the selection of "network resources that need to be upgraded". If a resource does not need to be upgraded, then it must have already been received. Selection of resources is impossible without determination. ; also column 5 lines 41-45: "In the server upgrader 22, several upgrade packages 7 and the corresponding installation instructions 20 are **grouped** 108 **into a "job"** 18. Within each job 18, the installation instructions for every package are included in a control file 18a." Comment: Grouping packages into a job is considered adding to an order list.); and

Ordering, receiving, and applying said items on said order list (column 4 lines 45-48 as cited above in addition to column 4 lines 48-53: "At the outset, the appropriate upgrade packages 7 are **retrieved** 102 from the distribution medium (or the on-line service) and **supplied** 106 to a server upgrader 22 located in the upgrade installer 17. Installation instructions 20 are retrieved 104 from the database 9 and are supplied 106 to the server upgrader 22.); also column 5 lines 48-63, "When the job is ready to be installed to the target server, the server upgrader connects with the server...and then sends the job...to a staging area. The staging area may...be anywhere else in the

network capable of handling the deposit and retrieval of upgrade files....the agent executes the instructions in the control file...").

As per claim 3, the above rejection of claim 1 is incorporated. Stupek further discloses the use of an operating system with the computer system (column 1 line 17).

As per claim 4, the above rejection of claim 3 is incorporated. Stupek further discloses the use of a network with the computer system (column 1 line 13).

As per claim 5, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of keeping track of what software has been installed or uninstalled (column 6 lines 45-47).

As per claim 6, the above rejection of claim 1 is incorporated. Stupek further disclose the use of a database application through the use of the "server database" (column 4 lines 14-16).

As per claim 7, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of storing information relating to program updates in a file (column 6 lines 43-45).

As per claim 8, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of updating software on the computer system (column 5 lines 48-63).

As per claim 9, Stupek discloses:

A system for maintaining software on a computer system (FIG. 1) comprising:
a maintenance application having a first list of third maintenance items wherein
the first list comprises a list of maintenance items needed to be applied to said computer
system (figure 1 reference 11 “Upgrade Advisor”; figure 1 reference 7 “Resource
Upgrades”, column 3 lines 31-43, “Upgrades to the network resources
are provided to a server manager by a distribution medium..”;
also column 3 line 57 – column 4 line 7: “When the upgrades 7 become
available to the network (e.g., by inserting the CD-ROM
into the server manager drive, or by logging into the on-
line service), an upgrade advisor 11 in the upgrade device
10 automatically analyzes each network resource 3 currently
*on the server 1 to determine the availability and **necessity***
***of the corresponding upgrade 7.** When the analysis is*
*complete, **the upgrade advisor 11 presents a report and/or***
graphical display to the user.”;

All other limitations have been addressed in the above rejection of claim 1.

As per claims 11-16, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejections of claims 3-8, respectively.

As per claim 17, all limitations have been addressed in the above rejections of claims 1 and 9.

As per claim 18, Stupek discloses a computer program product (column 3 lines 31-33). Stupek further discloses a computer readable medium and program instruction means (column 11 line 9 – column 14 line 33). All further limitations have been addressed in the above rejection of claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stupek et al as applied to claims 1 and 9, respectively, above, and further in view of “Y2K Compliance and the Distributed Enterprise” by Gowan et al.

As per claim 2, Stupek does not expressly disclose software maintenance on a mainframe.

However, in an analogous environment, Gowan et al. teaches the benefits of upgrading a mainframe computer system (page 68, paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Stupek's software maintenance system with Gowan's concept of upgrading a mainframe computer in order to facilitate a swift and automated upgrade process. This is desirable since mainframe computers serve a large number of users, and having a swift and automated upgrade process ensures the availability of correct and efficient software.

As per claim 10, all further limitations have been addressed in the above rejection of claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr



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